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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/749,377

01/02/2004

Yoshinori Utsunomiya

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,377

Applicant(s)

Utsunomiya et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 2, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the arguments filed by applicant on May 8, 2007 in reply to the previous Office action on the merits, mailed January 10, 2007.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on September 27, 2002. It is noted, however, that applicant has still not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. (US 5,581,682).

Anderson et al. disclose a method and apparatus for disclosing selected parts of a document to be made public, comprising the steps of: locating at least one character string of non-disclosure in the document by referring to an auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason; embedding a tag and the reason of non-disclosure corresponding to the character string in the document; and, replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed.

Regarding claims 4 and 6, the dictionary of Anderson et al. further contains at least one character string of compulsory disclosure associated with at least one corresponding reason, the program further comprising the steps of: locating the tag of non-disclosure in the document and determining if the character string corresponding to the tag of non-disclosure matches the character string of compulsory disclosure by referring to said dictionary; and replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure, and the retrieved reason of non-disclosure with the reason for compulsory disclosure, when the character string of non-disclosure corresponding to the retrieved tag is found in the said dictionary.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 5,581,682).

Anderson et al. disclose a computer-readable recording medium recorded with an information disclosure program for disclosing selected parts of a document to be made public, the program comprising the steps of: locating at least one character string of non-disclosure in the document by referring to an auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason; embedding a tag of non-disclosure and the reason of non-disclosure corresponding to the character string in the document according to said dictionary; and, replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed, but the document of Anderson et al. is not disclosed as being formatted in XML.

However, XML formatting is a well known, hence obvious, markup language to use in formatting an electronic document, and official notice to that effect is hereby taken.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Anderson et al. so as to have used XML to format the

document, as is well known to do, merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 2, the dictionary of Anderson et al. further contains at least one character string of compulsory disclosure associated with at least one corresponding reason, the program further comprising the steps of: locating the tag of non-disclosure in the document and determining if the character string corresponding to the tag of non-disclosure matches the character string of compulsory disclosure by referring to said dictionary; and replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure, and the retrieved reason of non-disclosure with the reason for compulsory disclosure, when the character string of non-disclosure corresponding to the retrieved tag is found in the said dictionary.

Response to Arguments

7. Applicant's arguments filed May 8, 2007 have been fully considered but are not persuasive.
8. Regarding the argument that the disclosure in Anderson et al. is not in as complete detail as is contained in the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

9. To the extent that applicant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

10. Regarding the argument that Anderson et al. fail to disclose an auxiliary storage unit storing a dictionary which contains the at least one character string of non-disclosure in association with at least one corresponding reason, Anderson et al. indeed disclose an auxiliary storage unit storing a dictionary which contains the at least one character string of non-disclosure in association with at least one corresponding reason. See, for example, the abstract and claims 1-5.

11. Regarding the argument that Anderson et al. fail to disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document, Anderson et al. indeed disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document. See, for example, the abstract and claims 1-5.

12. Regarding the argument that Anderson et al. fail to disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed, Anderson et al. indeed disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed. See, for example, the abstract and claims 1-5.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

September 4, 2007


Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

9/4/07